REMARKS

Claims 1-35 are pending in the application. Claims 1-6, 8-18, 20-28 and 30-35 are rejected. Claims 7, 19 and 29 are objected to, but contain allowable subject matter.

Applicant appreciates that prosecution has been reopened and a non-final office action has been issued, presenting new grounds of rejection. Applicant chooses to exercise the option of filing a reply under 37 C.F.R. 1.111.

Claim Objections

Claim 10 was objected to for informalities. Claim 10 has not been substantively amended, but rather an inadvertent typographical error was corrected (*i.e.*, the spaces surrounding a previous amendment were underlined), in order to address the Examiner's objection. Applicant respectfully requests that the objection of claim 10 be withdrawn.

Allowable Subject Matter

Applicant acknowledges and appreciates that the Examiner has indicated that claims 7, 19 and 29 contain allowable subject matter.

Claim Rejection – 35 U.S.C. 112

The Examiner rejected claims 23-31 under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the enablement requirement. Applicant respectfully traverses this rejection.

In the Office Action, the Examiner argues that "the limitation 'A computer readable program' was claimed," but support for such a claim is not found in the Specification. *See* Office Action, p.3. Applicants respectfully point out that the preamble of claim 23, read in proper context and in its entirety, recites "a computer readable program storage device encoded

with instructions," not simply a 'A computer readable program' as described by the Examiner. Bearing this in mind, the Specification offers exemplary embodiments of "a computer readable program storage device" which may be "encoded with instructions." For example, the Specification, Figures 2 & 3, show Memory Circuitry 250, as examples. Memory circuitry, as known by one of skill in the art, is computer readable, is able to store programs, and is able to be encoded with instructions. The Specification also discloses computer components capable of supporting the claim 23 language" "[T]he software must run to receive and process data packets, the processor, memory, and other major components of the computer, cannot be placed into a true low-power mode." Specification, p.4, ll. 8-10 (*emphasis added*). The Specification further describes memory, in exemplary embodiments, at Specification, page 8, lines 8-21.

For at least these reasons, the language "a computer readable program storage device encoded with instructions" is fully supported and enabled by the Specification. Applicant respectfully requests the rejections under 35 U.S.C. 112 be withdrawn.

Claim Rejection – 35 U.S.C. 103

In the present Office Action, the Examiner rejected claims 1-2, 9, 23-24, 31-32 and 34 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,802,305 *(McKaughan)* in view of U.S. Patent No 4,683,534 *(Tietjen)*. Applicant respectfully traverses this rejection.

For ease of illustration, claim 1 is discussed first. Claim 1, directed to a method, calls for, among other things, detecting a size of said received set of data signals to use as a factor for decoding said data and decoding said received set of data signals.

The Examiner's rejection of claim 1 is incorrect at least because **McKaughan** and **Tietjen**, either alone or in combination, do not teach or suggest all the claimed features. For example, claim 1 calls for detecting a size of said received set of data signals to use as a factor

for decoding said data. In the Office Action dated June 18, 2009, the Examiner admits that *McKaughan* does not teach this claimed feature. *See* Office Action, p.4. The Examiner, however, argues that *Tietjen* teaches this claimed feature because *Tietjen* describes "detecting a size of said received set of data signals to use as a factor for decoding said data (col. 3, lines 2-5)." *Id* . The cited passage in *Tietjen* states: "Size decoder 18 decodes the size control signal and provides a size select signal indicative of the number y of consecutive least significant bits of the size control signal which are equal to one (1)." *Tietjen*, col. 3, ll. 2-5. A careful reading of *Tietjen* in full context reveals that *Tietjen* actually discloses that the "size control signal" does **not** give the size of the received sets of data signals; rather, *Tietjen* teaches that "size control signal" is a concatenation of the address bits An-A1 and the decode control bit As. *See Tietjen*, col. 2, line 62 to col. 3, line 5. The size decoder 18 generates a size select signal from the size control signal, and the size select signal determines how many of the unit-enables are activated (that is, how many data units are coupled from bus 12 to bus 14). *See id.* at col. 2, line 62 to col. 3, line 58.

As can be seen, the "size control signal" and the "size select signal" are **not** the results of (or means to-) detecting a size of the received set of data, as called for in claim 1. The "size control signal" and the "size select signal" are merely used to determine how much of the data payload will be coupled between busses (*i.e.*, bus 12 and bus 14). In other words, size of the incoming data in *Tietjen* is not determinative of decoding; as a matter of fact, decoding in *Tietjen* depends on **how the address bits are set** (*i.e.*, what is the configuration of the address bits: 000, 001, 010, 011, 100, 101, etc.), not how big the data packets are. As such, *Tietjen* does not teach detecting a size of the received set of data. Further, *McKaughan* fails to remedy this deficiency in *Tietjen*.

Claim 1 also calls for <u>decoding said received set of data signals</u>. In the Office Action, the Examiner argues this feature is allegedly taught by *McKaughan* because *McKaughan* teaches masking certain extraneous fields of an incoming packet. *See* Office Action, p.3. Applicant respectfully disagrees because masking bits in a packet, as taught in *McKaughan*, is not <u>decoding</u>, as recited in claim 1. Masking, as would be understood by one of skill in the art at the time this Application was filed, is the removal of bits for purposes of examination of data, and such masking is indicated by *McKaughan*. In other words, if bits are masked, they are simply ignored by a data reader. Decoding, on the other hand, is not merely masking. *See, e.g.,* Specification, Fig. 2 (detailing logic comprising detector/decoder 130). For example, decoding may involve clock dividing, data formatting, storing, comparing, logic filtering and the like (which are offered as non-limiting examples). *See* Specification, p.10, line 24 to p.12, line 16. In other words, claim 1 calls for the <u>data to be decoded</u>. In contrast, *McKaughan* does not call for <u>data decoding</u>, but for bit masking in which the data is not decoded. To illustrate, the Examiner is respectfully requested to consider how *McKaughan* describes that the filtered packet is compared to stored packets in the network interface card 22 RAM 27. *See McKaughan*, col. 8, ll. 52-54. Put another way, *McKaughan* is *comparing* packets, not <u>decoding</u> data as recited in claim 1. Applicant submits that a simple masking/comparison is **not** decoding, and as such, *McKaughan* does not teach this claimed feature. *Tietjen* fails to remedy the fundamental deficiencies of *McKaughan*.

For at least the aforementioned reasons, claim 1 and its dependent claims are allowable. For at least similar reasons, claims 23, 32, and 34 (and their respective dependent claims) are also allowable.

Further, without using improper hindsight reasoning, those skilled in the art would not combine *Tietjen* and *McKaughan* in such a manner as claimed by the present application. Applicants respectfully assert that *McKaughan*, *Tietjen*, and/or their combination do not teach or disclose all of the elements of claims 1, 23, 32, and 34 of the present invention. In order to establish a prima facie case of obviousness, the Examiner must consider the following factors: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference(s) must teach or suggest all the claim limitations. MPEP § 2143 (2005) (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). In making an obviousness rejection, it is <u>necessary</u> for the Examiner to <u>identify the reason why</u> a person of ordinary skill in the art would have combined the prior art references in the manner set forth in the claims. *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007). Applicants respectfully submit that the Examiner has not met this burden. If fact, as illustrated herein, *McKaughan* and *Tietjen* are incompatible, and consequently those skilled in art would not combine them and make all of the elements of claims of the present invention obvious. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established in rejecting claims 1-2, 9, 23-24, 31-32 and 34.

McKaughan refers to a computer network that contains a plurality of interconnected computers, wherein a network interface card of sleeping computers detects an incoming packet and compares the incoming packet to a list of packets stored on the network interface cards. In contrast *Tietjen* is directed to performing address interfacing for busses of different widths. *Tietjen* does not even mention the terms sleep or sleep mode. The Examiner uses improper hindsight reasoning to combine *McKaughan* and *Tietjen* in the manner set forth in the claims.

Further, the Examiner failed to identify any reason why those skilled in the art would combine

McKaughan and *Tietjen* in the manner set forth in the claims. *KSR Int'l Co. v. Teleflex, Inc.*,

550 U.S. 398 (2007). Accordingly, the Examiner failed to establish a *prima facie* case of

obviousness has not been established in rejecting claims 1-2, 9, 23-24, 31-32 and 34.

Without using improper hindsight reasoning and using the claim as a roadmap, the person

of ordinary skill in the art would have no apparent reason to modify the references to arrive at

the subject matter of claim 1. The Examiner essentially provided a conclusory statement that

adding the features of these references together would make for a better product; *i.e.*, the

Examiner has simply stated the result of such a combination. *See* Final Office Action, p.4

(stating

> One skilled in the art would have recognized the detecting a size of said received
> set of data signals, and would have applied Tietjen et al.'s size decoder 18 in
> McKaughan et al.'s detects an incoming packet over the network. Therefore, it
> would have been obvious to one of ordinary skill in the art at the time of the
> invention, to use Tietjen et al.'s method and apparatus for interfacing buses of
> different sizes in McKaughan et al.'s system for remotely waking a sleeping
> computer in power down state by comparing incoming packet to the list of
> packets storing on the network interface card with the motivation being to provide
> a size select signal (col. 3, line 3).").

It is unclear, and the Examiner has offered no explanations, why a person of skill in the art

would look to combine teachings for interfacing busses of different widths with the teachings of

remotely waking sleeping computers. Such a statement lacks any factual, logical or reasonable

basis. Additionally, the Examiner has not pointed to any teachings in the cited references that

would **motivate** a person of skill in the art to combine the references. In other words, the

question that must be addressed includes "*why* would a person have thought to combine the cited

references based on their teachings?", not simply "what benefits would result?". Motivation to

combine aside, as discussed above, even if *McKaughan* and *Tietjen* were to be combined, claim 1 as a whole would be untaught and non-obvious over the references.

Therefore, claims 1-2, 9, 23-24, 31-32 and 34 are allowable for at least the reasons cited herein.

Additionally, claims 3-6, 8, 10-18, 20-22, 25-28, 30, 33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over *McKaughan*, in view of *Tietjen* and further in view of U.S. patent No. 4,516,201 *(Warren)*. Applicant respectfully traverses this rejection.

To the extent the Examiner relies upon *McKaughan*, in view of *Tietjen* to reject claims 1-2, 9, 23-24, 31-32 and 34, Applicant has pointed out that *McKaughan* and *Tietjen*, either alone or in combination, do not teach all the claimed features of claims 1-2, 9, 23-24, 31-32 and 34. *Warren* fails to make up for these deficiencies. As such, claims 3-6, 8, 25-28, 30, 33 and 35, which depend from claims 1, 23, 32 and 34, are allowable due at least to the nature of their respective dependencies.

With respect to claim 10, Applicant respectfully submits that all claimed features of claim 10 are not taught by *McKaughan* and *Tietjen*, either alone or in combination, for at least similar reasons as argued above with respect to claim 1. *Warren* fails to make up for the deficiencies found in *McKaughan* and *Tietjen*. For at least these reasons, claim 10 (and its dependent claims) are also allowable.

For at least the reasons cite above, combining *Warren*, with the disclosure of *Tietjen* and/or *McKaughan*, would still not result in disclosing or making obvious all of the elements of any of the claims of the present invention. Therefore, claims 3-6, 8, 10-18, 20-22, 25-28, 30, 33, and 35, are not taught, disclosed, or made obvious by *McKaughan*, *Tietjen*, *Warren*, or any

combination thereof. Accordingly, claims 3-6, 8, 10-18, 20-22, 25-28, 30, 33, and 35 are allowable for at least the reasons cited above.

Applicant respectfully asserts that in light of the amendments and arguments provided by Applicant throughout the prosecution of the present application, all claims of the present application are now allowable and, therefore, request that a Notice of Allowance be issued.

Reconsideration of the present application is respectfully requested.

If for any reason the Examiner finds the application other than in condition for allowance, the **Examiner is respectfully requested to call the undersigned attorney** at the Houston, Texas telephone number (713) 934-4069 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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